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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,106	06/02/2000	David A. Wright	P-1065	6179

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EXAMINER

KATCHEVES, KONSTANTINA T

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/586,106

Applicant(s)

WRIGHT ET AL.

Examiner

Konstantina Katcheves

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

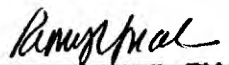
Claim(s) allowed: 15-18, 21-23, 25 and 28-33.

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 9-12, 26 and 27.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejections of claims 15-18, 21-23, 25 and 28-33 have been withdrawn.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments fail to overcome the rejections of record under the written description requirement of 35 U.S.C. 112, first paragraph. Applicant argues that it is the word "portion" in the claims and specification is clear evidence that the inventors recognize that the nucleic acid need not encode a functional reverse transcriptase. The Specification, when considered as a whole does not clearly indicate that a functional reverse transcriptase is required. In fact even in the Summary of the Invention on page 4 of the Specification, Applicant states that the construct has "retroelement sequences that allow for replication and integration." It is the Examiner's understanding that a non-functional reverse transcriptase would not allow for replication and integration of the construct as such Applicant's specification contemplates a functioning reverse transcriptase such that Applicant has not described the genus of the claims. As a practical matter, it is untenable that Applicant assert that they have possession and have presented a representative number of species of the almost innumerable number of sequences embraced by the broad genus of sequences having 85% or 95% identity to the nucleic acid sequence of SEQ ID NO:62 and the nucleic acid sequence encoding SEQ ID NO:63.

Regarding the rejections under the enablement requirement of 35 U.S.C. 112, first paragraph. Applicant argues that the "evaluation of enablement is not directed to making and using a functional reverse transcriptase," rather to making and using a nucleic acid construct having a sequence with more than 85% or 95% identity with the claimed sequences. Although one of skill in the art could make such a sequence, the question remains as to how one of skill in the art would use such a construct. Applicant's specification contemplates that the sequences allow for replication and integration. If sequences having 85% or 95% identity with SEQ ID NO:62 or a construct having 85% or 95% identity to the nucleic acid sequence encoding the protein of SEQ ID NO:63 is not necessarily functional, how would one of skill in the art use the construct. Applicant has yet to satisfactorily answer this question.